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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,549	04/18/2001	John N. Randall	RAND-37	9264

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EXAMINER

KOCH, GEORGE R

ART UNIT PAPER NUMBER

1734

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/838,549

Applicant(s)

RANDALL ET AL.

Examiner

George R. Koch III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's election without traverse of group I, claims 1-12 in the reply filed on 6/03/2005 is acknowledged.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claims 1-7, the phrase "or similar substances" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05.

5. Regarding claims 8-12, the phrase "or similar substances" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 4, 6, 8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida (US Patent 5,932,012).

As to claim 1, Ishida discloses an automated mechanism capable of depositing oil paint or similar substances on a canvas (Figure 1).

As to claim 3, Ishida discloses that the automated mechanism uses a syringe to deposit the paint (item 2).

As to claim 4, Ishida discloses an automated mechanism capable of depositing and redistributing oil paint or similar substances on a canvas (Figure 1).

As to claim 6, Ishida discloses that the automated mechanism uses a syringe to deposit the paint (item 2).

As to claim 8, Ishida discloses an automated mechanism capable of depositing oil paint or similar substances on a canvas comprising: an attachment mechanism (substrate attracting table 13) through which a canvas suitable for painting is capable of being held in place, a deposition mechanism (item 2) for depositing a selectable amount of material such as paint through a well defined opening (the hole of the syringe) onto a substrate capable of being a canvas which is held by the attachment mechanism, a motion control mechanism (items 15a, 15b, and 15c), attached to the deposition mechanism to move said deposition mechanism to a desired position with respect to the substrate, such as a canvas, and a control system (item 14 and Figure 3) which receives external data (from item 11a) describing an amount of given paint which is to

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be deposited at a predetermined position on the canvas and which controls the motion control system and paint deposition system.

As to claim 12, Ishida discloses that the automated mechanism uses a syringe to deposit the paint (item 2).

8. Claims 1, 2, 4, 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by McNeely (US 3,321,331)

As to claim 1, McNeely discloses an automated mechanism capable of depositing oil paint or similar substances on a canvas (Figure 1).

As to claim 2, McNeely is capable of moving in three dimensions.

As to claim 4, McNeely discloses an automated mechanism capable of depositing and redistributing oil paint or similar substances on a canvas (Figure 1).

As to claim 5, McNeely is capable of moving in three dimensions.

As to claim 7, McNeely discloses that the automated mechanism uses a brush to redistribute the oil coating (item 44).

9. Claims 1-6, 8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Penn (US 5,594,652)

Penn discloses an automated mechanism capable of depositing oil paint or similar substances on a canvas (Figure 1a).

As to claim 2, Penn is capable of moving in three dimensions (see column 8, lines 21-41).

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As to claim 3, Penn discloses that the automated mechanism can use a syringe as an alternative to a printhead to deposit the substance (column 12, lines 46-58).

As to claim 4, Penn discloses an automated mechanism capable of depositing and redistributing oil paint or similar substances on a canvas (Figure 1a).

As to claim 5, Penn is capable of moving in three dimensions (see column 8, lines 21-41).

As to claim 6, Penn discloses that the automated mechanism uses a syringe to deposit the substance (column 12, lines 46-58).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida as applied to claim 8 above, and further in view of Barlage (US 5,859,775).

Ishida discloses all of the elements of claim 8, and includes various driving motors (15a, 15b, and 15c) but is silent as to the presence of any additional structures such as the belts.

However, Barlage discloses that it is known to utilize belts and drive shafts in conjunction with the motors. One in the art would appreciate that these elements ensure proper translation of the substrate relative to the coating dispenser. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have utilized the belts in order to provide proper translation and positioning.

13. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida as applied to claim 8 above, and further in view of McNeely (3,321,331).

As to claims 9 and 10, Ishida does not suggest an additional implement, such as a brush, for spreading the coating material over the substrate.

McNeely discloses utilizing brushes (item 44) to spread and distribute a coating (sprayed from nozzles 66). McNeely discloses that these brushes ensure that substrate is properly coated (for example, see column 1, lines 13-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such brushes in order to properly apply and spread the coating.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Koch III whose telephone number is (571) 272-1230 (TDD only). If the applicant cannot make a direct TDD-to-TDD call, the

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applicant can communicate by calling the Federal Relay Service at 1-866-377-8642 and giving the operator the above TDD number. The examiner can normally be reached on M-Th 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George R. Koch III  
Patent Examiner  
Art Unit 1734

GRK  
6/12/2005